

REMARKS

The final office action dated March 8, 2007 has been received and its contents carefully noted.

Claims 40 – 68 are pending in the application.

Claims 40 – 68 are rejected.

No claims are amended or cancelled.

In response thereto Applicant respectfully requests reconsideration of the claims of record and offers the following cogent reasoning on the prior art of record in support thereof.

Applicant's invention as disclosed and claimed relates to a portable device for connection to a person. There are two different sets of embodiments of the invention.

Independent claims 40 and 48 relate to the first set of embodiments in which a device (such as a mobile telephone) comprises a releasable connector. In response to the release of the releasable connector, the device is at least partially disabled.

Independent claims 54 and 59 relate to the second set of embodiments in which a device is partially disabled in response to the diminution of a radio link between the device and a counterpart device.

Independent claim 63 generally refers to "unauthorized removal of the device from a person porting the device" and relates to both the first set of embodiments and the second set of embodiments.

Claim rejections 35 U.S.C. §§102 and 103

In Section 4 of the final office action, the Examiner has rejected independent claims 54 and 63 and dependent claims 55-56 under 35 U.S.C. §102(b) as being completely anticipated by Sasakura et al. (US Patent No. 6,151,493).

In Section 5 of the final office action, the Examiner has rejected independent claims 40, 48 and 59 and dependent claims 41-45, 49-52, 60-61 and 64 under 35 U.S.C. §103(a) as being unpatentable over Sasakura et al. (US Patent No. 6,151,493) in view of Briffett et al. (US Patent No. 6,154,665).

In Section 6 of the final office action, the Examiner has rejected dependent claims 46-47, 53, 57, 58 and 62 under 35 U.S.C. §103(a) as being unpatentable over Sasakura et al. (US Patent No. 6,151,493) in view of Briffett et al. (US Patent No. 6,154,665) and further in view of Rohrbach (US Patent No. 5,898,783).

In Section 7 of the final office action, the Examiner has rejected dependent claims 65 and 67 under 35 U.S.C. §103(a) as being unpatentable over Sasakura et al. (US Patent No. 6,151,493) in view of Decotignie (US Patent Publication 2001/0016484).

In Section 8 of the final office action, the Examiner has rejected dependent claims 66 and 68 under 35 U.S.C. §103(a) as being unpatentable over Sasakura et al. (US Patent No. 6,151,493) in view of Briffett et al. (US Patent No. 6,154,665) and further in view of Decotignie (US Patent Publication 2001/0016484).

Applicant respectfully disagrees with the Examiner's rejection of these claims.

Sasakura deals with preventing or prohibiting the use of cellular phones or other devices by unauthorized individuals if they are left behind or lost. In Sasakura, the owner of a cellular phone 30 wears a transmission unit 10. The transmission unit 10 sends a signal to the phone 30 to keep it in operation. When the phone 30 is more than a predetermined distance from the transmission unit 10, and the strength of the signal sent by the transmission unit 10 drops below a threshold level, the phone 30 is disabled using the canceling unit 20 and the AND gate 36a in the phone 30 (see column 4, lines 14 to 28).

The canceling unit 20 provides an input to AND gate 36a. If the signal presence determination unit 22b in the canceling unit 20 determines that no ID signal is being received from the transmission unit 10, it outputs a signal to stop a signal generator 26 from producing a use prohibition canceling signal to the AND gate 36a. It appears that if this canceling signal is not sent from the signal generator 26 to the AND gate 36a via the switch 37c, the user will be unable to use the number and function keys 37a. Therefore, if a signal is not received from a transmission unit 10, the cellular phone 30 is completely disabled.

Briffett relates to a mobile telephone 1 comprising a telephone proximity unit 16 and a belt clip assembly 20 comprising a belt clip proximity unit 46. The telephone proximity unit 16 comprises a detecting contact 82 and the belt clip proximity unit 46 comprises a detecting contact 62. When the telephone 1 is situated in the belt clip assembly 20, the detecting contacts 62, 82 electrically contact each other. In the absence of electrical contact between the detecting contacts 62, 82, the telephone proximity unit 16 and the belt proximity unit 46 are switched on (column 4, lines 36 to 39). The telephone proximity unit 16 then transmits a master proximity signal S2 to the belt proximity unit 46. After receiving the master proximity signal S2, the belt proximity unit 46 transmits a slave acknowledgement proximity signal S1 to the telephone proximity unit 46.

If the telephone proximity unit 16 does not receive the signal S1 (e.g. because it is not within the transmission range of the belt clip proximity signal 46), the telephone proximity unit 16 sounds an alarm and sends instructions to a microprocessor 4 of the telephone 1 “which switches the telephone 1 from its normal mode in which it waits to have a PIN number entered and all other functions of the telephone, such as the capability to receive or place a call, are unavailable to the user” (column 4, line 62 to column 5, line 10).

The Examiner has rejected independent claims 40 and 48 in the Office Action, on the basis that they are obvious in view of the disclosures made in Sasakura and Briffett.

The Examiner has argued that Sasakura discloses “unauthorized separation detection means” and “control means arranged to effect at least partial disablement of the device” of independent claim 40 but does not teach the “release of a releasable connector connecting the device to the person”. The Examiner asserts that this feature corresponds to the belt clip assembly 20 disclosed in Briffett. Applicant disagrees with the Examiner’s assertion.

The Examiner appears to be considering independent claim 40 incorrectly. Claim 40 recites that the device comprises:

“control means arranged to effect at least partial disablement of the device in response to the release of the releasable connector”.

Sasakura makes no mention of any releasable connector, and so Sasakura clearly does not teach, disclose or suggest the structural limitation of “control means arranged to effect at least partial disablement of a device in response to the release of a releasable connector.

Turning now to Briffett, it is stated at column 4, lines 34 to 39 that “[w]hen the telephone 1 is removed from the belt clip proximity unit 46, it is in a so-called ‘away position’ in which there is no electrical contact between the detecting contacts 62, 82. The absence of electrical contact between the detecting contacts triggers the detection circuitries 61, 81 which switch on the proximity units 46, 16”.

The telephone 1 is not, however, partially (or fully) disabled in response to it being removed from the belt clip proximity unit 46. Briffett does not therefore teach, disclose or suggest a device comprising “control means arranged to effect at least partial disablement of the device in response to the release of the releasable connector” as recited in claim 40.

No disablement of the telephone 1 occurs unless the signals S1 and S2 are not successfully exchanged by the telephone proximity unit 16 and the belt clip proximity unit 46. Briffett therefore teaches away from embodiments of the invention because it teaches that no disablement of the telephone 1 should occur when the physical connection between the telephone 1 and the belt assembly clip 20 is severed. Instead, Briffett teaches that the telephone should remain fully operational until the

telephone 1 is a given distance away from the belt clip assembly (i.e. a distance which is greater than the transmission range of the telephone proximity unit 16 and/or the belt clip proximity unit 46), and only then should any disablement of the telephone 1 occur. The modification suggested by the Examiner would render Briffett unsuitable for its intended purpose,

Independent claim 48 also recites the structural limitation of “a controller arranged to effect at least a partial disablement of the device in response to the release of the releasable connector.”

Applicant’s invention as disclosed and claimed in independent claims 40 and 48 are novel and unobvious and recite structural limitations not shown or suggested by the cited art of record.

As indicated above, the Examiner has rejected independent claim 54 as being anticipated by Sasakura. The Examiner appears to consider that the cellular phone 30 in Sasakura corresponds to the “device” recited in claim 54. Applicant disagrees with the Examiner’s assertion.

The cellular phone 30 in Sasakura does not comprise “a controller arranged to effect partial disablement of [a] device in response to unauthorized separation of the device and [a] counterpart device” as required by independent claim 54. When the phone 30 in Sasakura is disabled because it is more than a predetermined distance from the transmission unit 10, the inability to use the number and function keys 37a of the cellular phone 30 in Sasakura means that the cellular phone 30 is completely disabled and not “partially disabled”. The cellular phone 30 has no functionality once the number and function keys 37a have been disabled. If the cellular phone 30 in Sasakura were “partially disabled”, it would still have some functionality.

Applicant’s have carefully studied the Sasakura reference and cannot identify where Sasakura discloses that the cellular phone 30 has some functionality once the number and function keys 37a have been disabled, nor has the Examiner identified this structural limitation. Accordingly, Saskura is deficient with respect to this structural limitation and therefore cannot anticipate Applicant’s invention as disclosed and claimed.

Sasakura explicitly teaches that a cellular phone 30 should be completely disabled in response to it being separated from a transmission unit 10. There is nothing in Sasakura that would lead a person skilled in the art to adapt the cellular phone 30 so that it were “partially disabled” in any eventuality. Sasakura therefore provides no motivation for a person skilled in the art to develop anything that would fall within the scope of independent claim 54. The modification suggested by the Examiner would render Sasakura unsuitable for its intended purpose.

In the embodiments of the invention as disclosed and claimed, the partial disablement of the telephone results in the telephone not being capable of normal use (as described in the paragraph bridging pages 2, lines 26-31 and 3, lines 1-2 of Applicant’s specification). However, advantageously,

when the telephone is partially disabled it may be capable of making emergency calls. Partial disablement of the telephone may also allow the telephone to make calls to a network operator call centre and/or re-direct restricted calls to/from the telephone to a network operator call centre.

Independent claim 63 also recites the structural limitation of “control means arranged to effect partial disablement of the device in response to the unauthorized removal of the device from the person porting the device.”

Applicant’s invention as disclosed and claimed in independent claim 54 is submitted to be novel and non-obvious for at least the above reasoning. Likewise, independent claim 63 is submitted to be novel and non-obvious for the same reasons as independent claim 54.

The Examiner has rejected independent claim 59 in the Office Action, on the basis that it is obvious in view of the disclosures made in Sasakura and Briffett. Applicant disagrees with the Examiner’s assertion.

The Examiner appears to have misread or misinterpreted the structural limitations of independent claim 59.

Independent claim 59 recites:

*“[a] device wearable by a person comprising:
a detector arranged to detect the unauthorized separation of the device from a
counterpart device by detecting the diminution of a radio link between the device and the
counterpart device; and
a controller arranged to effect partial disablement of the counterpart device in response
to the unauthorized separation of the device and counterpart device, by controlling a
transceiver to transmit a radio command to the counterpart device”.*

In the embodiments of the invention as disclosed and claimed, a controller of the device is arranged to effect partial disablement of a counterpart device.

The Examiner in the Office Action at page 8 appears to have erroneously considered that claim 59 recites:

*“[a] device wearable by a person comprising... a controller arranged to effect partial
disablement of the device”.*

The Examiner has indicated that he is considering the cellular phone 30 in Sasakura to be equivalent to the “device” and the transmission unit 10 to be equivalent to the “counterpart device”. However, in Sasakura the cellular phone 30 does not effect partial disablement of the transmission unit 10. There is therefore no teaching, disclose or suggestion of “[a] device... comprising... a controller arranged to effect partial disablement of [a] counterpart device” as required by independent claim 59.

Furthermore, there does not appear to be any reason why a person skilled in the art would wish to use the cellular phone 30 to partially disable the transmission unit 10. There would therefore be no motivation for a person skilled in the art to develop anything that would fall within the scope of independent claim 59 from the reading of Sasakura. Applicant submits the modification suggested by the Examiner would render Sasakura unsuitable for its intended purpose.

Applicant's invention as disclosed and claimed in independent claim 59 is submitted to be novel and non-obvious for at least the above reasoning.

The Examiner rejects dependent claims 46, 53, 58 and 62 as being unpatentable over Sasakura in view of Briffett and further in view of Rohrbach. Applicant respectfully disagrees with the rejection of these claims.

Applicant's dependent claim 46 recites that a device:

"is or comprises a cellular mobile telephone for operation in a cellular communications network and the control means is arranged to effect at least partial disablement of the device by sending a disabling message to the cellular communications network instructing the cellular communication network to disable normal operation of the telephone in the cellular communications network".

Dependent claims 53, 58 and 62 are of a similar scope.

Rohrbach discloses a SIM card 110 comprising data communication circuitry 200, logic circuitry 210 and disabling circuitry 220. Data communication circuitry 200 is operative to transmit a code identifying the SIM card 110, from logic circuitry 210 within the card, to a telecommunications network via a mobile station 100. The telecommunications network searches a disable database and returns a disable command if the unit code identifying the SIM card 110 is found in the disable database. In response to receiving a disable command, the disabling circuitry 220 is operative to incapacitate the logic circuitry 210 to prevent or limit further operation thereof, the SIM card thereby being incapacitated with respect to the telecommunications network and systems independent of telecommunications network (see column 4, lines 13 to 25).

As indicated in the remarks filed on 19th December 2006, in Rohrbach, the code that is transmitted from the SIM card 110 to the network via the mobile station 100, is merely an identification code that identifies the SIM card 110 in the mobile station 100. The message does not explicitly instruct the network to disable the SIM card. The SIM card 110 is only disabled if the unique code identifying the SIM card 110 is found in the disable database. If the unique code identifying the SIM card 110 is not found in the disable database, the SIM card 110 will not be

disabled. The code therefore does not provide any sort of instruction. In Rohrbach, the decision to disable the SIM card is made at the network, rather than at the SIM card 110 or the mobile station 100.

Rohrbach, therefore, does not teach, suggest or disclose a device comprising control means, where the device "is or comprises a cellular mobile telephone for operation in a cellular communications network and the control means is arranged to effect at least partial disablement of the device by sending a disabling message to the cellular communications network instructing the cellular communication network to disable normal operation of the telephone in the cellular communications network".

Applicant's invention as disclosed and claimed in dependent claims 46, 53, 58 and 62 is submitted to be novel and non-obvious for at least the above reasoning and for similar structural limitations found in their respective independent claims from which they depend.

Decotignie discloses a mobile telephony device intended for accommodating a user identification module. If an identification module is placed inside the device and which module is not the one that is linked to the device, the device goes into a first blocking state in which "it can no longer receive an incoming call nor transmit an outgoing call (possibly with the exception of emergency numbers)" (paragraph (0027), page 2).

However, it is clear that the teachings of Sasakura are completely incompatible with the teachings of Decotignie. Disablement of the cellular phone 30 in Sasakura results in the number and function keys 37a of the cellular phone 30 being completely disabled. It is therefore unclear how a person skilled in the art would adapt the cellular phone 30 of Sasakura so that it is capable of making calls to emergency numbers. The intention of Sasakura is clearly to completely disable the device, so that no calls can be made. The modification asserted by the Examiner would render Sasakura unsuitable for its intended purpose.

The combination of the teachings of Decotignie with Sasakura as suggested by the Examiner does not overcome the fundamental deficiencies of Sasakura nor does the combination teach, disclose or suggest applicant's invention as disclosed and claimed. Applicant respectfully requests withdrawal of the rejection of dependent claims 65 and 67 for at least the reasoning set forth above with respect to Sasakura and Decotignie.

Likewise, the addition of the teachings of Briffett to the Sasakura-Decotignie combination do not teach, disclose or suggest Applicant's invention as disclosed and claimed. Applicant respectfully requests withdrawal of the rejection of dependent claims 66 and 68 for at least the reasoning set forth above with respect to Sasakura and Decotignie.

Applicant further submits the proposed modifications render the prior art unsatisfactory for its intended purpose. If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In *re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) (Claimed device was a blood filter assembly for use during medical procedures wherein both the inlet and outlet for the blood were located at the bottom end of the filter assembly, and wherein a gas vent was present at the top of the filter assembly. The prior art reference taught a liquid strainer for removing dirt and water from gasoline and other light oils wherein the inlet and outlet were at the top of the device, and wherein a pet-cock (stopcock) was located at the bottom of the device for periodically removing the collected dirt and water. The reference further taught that the separation is assisted by gravity. The Board concluded the claims were *prima facie* obvious, reasoning that it would have been obvious to turn the reference device upside down. The court reversed, finding that if the prior art device was turned upside down it would be inoperable for its intended purpose because the gasoline to be filtered would be trapped at the top, the water and heavier oils sought to be separated would flow out of the outlet instead of the purified gasoline, and the screen would become clogged.).

To combine references, as set out in the MPEP at 706.02(j), the Examiner must establish a *prima facie* case of obviousness, which requires first, that there be "some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings," second, that "there must be a reasonable expectation of success," and third, that the combination made in the Office "teach or suggest all the claim limitations." Applicant respectfully submits the Examiner has failed to make a proper modification and combination for at least the reasoning set forth above.

In addition to the above, the various applied prior art references offer no teaching which would prompt the artisan of ordinary skill to make the combinations/modifications proposed by the Examiner. In fact, it is only when the Examiner looks to Applicant's own disclosure that he can allege obviousness by choosing bits and pieces of the prior art references and then combining these bits and pieces together based on alleged obviousness. Without a teaching (other than Applicant's own teaching) to prompt the combinations/modifications, the rejections are merely improper hindsight reconstruction of Applicant's own invention using Applicant's own disclosure. The Court of Appeals for the Federal Circuit has steadfastly criticized such modification. "The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). See also, e.g., *In re Laskowski*, 871 F.2d 115, 10 USPQ 2d 1397 (Fed. Cir. 1989); *Interconnect*

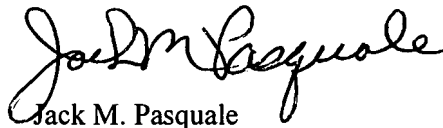
Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985); In re Grabiak, 769 F.2d 729, 731, 226 USPQ 870, 872 (Fed. Cir. 1985); In re Sernaker, 701 F.2d 989, 994, 217 USPQ 1, 5 (Fed. Cir. 1983).

In sum, it is submitted that the present invention as claimed is readily distinguishable from the applied references for the reasons indicated. Applicant's invention is not disclosed by the applied references and there is no fair basis for alleging that Applicant's invention is obvious in regard to them. If the invention was obvious, it would have been adopted before in view of its advantages.

Conclusion

Applicant submits that all the claims of the application are now in condition for allowance and earnestly solicits such action at an early date. The Examiner is invited to call applicant's attorney if any questions remain following review of this response.

Respectfully submitted,



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